

CAT/34-SCRO-US



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: SCROGGIE ET AL.

SERIAL NO.: 08/873,974

GROUP ART UNIT: 2163

CPA FILED: AUGUST 17, 1999

EXAMINER: ROBINSON, BOYCE A.

FOR: SYSTEM AND METHOD FOR  
DISTRIBUTING INFORMATION  
THROUGH COOPERATIVE  
COMMUNICATION NETWORK SITES

ASSISTANT COMMISSION FOR PATENTS  
WASHINGTON, D.C. 20231

37 CFR 1.193(b) REPLY BRIEF

SIR:

In response to the Examiner's Answer mailed on March 11, 2003, applicants submit the following reply brief.

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**I. Incorrect Address on Page 14 of the Examiner's Answer**

On page 14, the Examiner's answer contains an incorrect correspondence address, stated as:

Oblon Spivak McClelland Maier & Neustadt PC  
Fourth Floor  
1755 Jefferson Davis Highway  
Arlington, VA 22202

On August 5, 2002 I submitted a 37 CFR 1.33(a) Change in Correspondence Address instructing that all papers be sent to:

Neifeld Law, PC  
2001 Jefferson Davis Hwy, Suite 1001  
Arlington, VA 22202

Send all papers to the correct correspondence address and please list the correct correspondence address in the next paper.

**II. The Examiner's Admission that the 112 Rejections of Claims 63-69, 73-79, and 83-89 are Not Sustainable on Appeal**

On page 13 lines 17-21, the examiner's answer states that:

Finally, the appellant argues that the 12 limitations identified that the examiner asserts are not supported by the specification are supported by the specification. Upon review of the appellant's citing to the original disclosure, the examiner has withdrawn the 35 USC 112 rejection to claims 63-66, 73-76 and 83-86 and all claims that depend from them (claims 67-69, 77-79 and 87-89).

In reply, the applicant notes that the examiner admits that the 35 USC 112 rejections are not sustainable on appeal. The examiner can not "withdraw" a rejection on appeal. Accordingly, the panel should expressly reverse the rejections of these claims in the decision.

**III. Admission that the 102(e) Rejection of Claim 54 is Not Sustainable on Appeal**

In the office action mailed September 23, 2002, the examiner rejected claims 50, 51, 54, 60, 61, 70, 71, 80, and 81 under 35 USC 102(e) based upon Sloane. In the examiner's answer

mailed on March 11, 2003, the examiner stated that claims 50, 51, 60, 61, 70, 71, 80, and 81 stand rejected under 102(e) based upon Sloane, but did not include claim 54 in that statement. Thus, the examiner admits that the rejection of claim 54 under 102(e) is not sustainable.

#### **IV. The New Rejections are Improper and Therefore Should Not be Considered**

In the office action mailed September 23, 2002, the examiner rejected claims 52-53, 55-59, 62, 72, and 82 under 35 USC 103(a) based upon Sloane and Narasimhan et al. In the examiner's answer mailed on March 11, 2003, the examiner alleged that claims 52-59, 62-69, 72-79, and 82-89 stand rejected under 103(a). In fact, claims 54, 61-68, 73-79, and 83-89 do not stand rejected under 103(a). 37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. It is generally the law that late presented arguments in patent cases are excluded from consideration. Cf. Becton Dickinson & Co. v. C. R. Bard, Inc., 922 F.3d 792, 800 (Fed. Cir. 1990) and Johns Hopkins University v. Cellpro, Inc., 152 F.3d 1342, 1361 (Fed. Cir. 1998) ("New arguments cannot be raised for the first time on appeal, and cannot be raised in a reply brief."); and General Instrument Corp. Inc. v. Scientific-Atlanta Inc., 995 F.2d 209, 212, 27 USPQ 1145, 1146-47 (Fed. Cir. 1997); 36 CFR 1.655(c) ("If a party does not raise an issue via a preliminary motion, the party is not entitled to be heard at final hearing on that issue."); and Bayles v. Elbe, 16 USPQ2d 1389, 1391 (PTOBPAI 1990); Payet v. Swidler, 207 USPQ 168, 170 (PTOBPAI 1980); Fredkin v. Irasek, 397 F.2d 342, 346, 158 USPQ 280, 284 (CCPA 1968); and 37 CFR 1.655(b) ("A party cannot raise a new argument at final hearing for granting a motion if the argument was not presented in the original motion, unless the party shows good cause why the argument was not earlier presented."). Accordingly, the panel should ignore the alleged rejections of claims 51, 61-68, 73-79, and 83-89 under 103(a) and all arguments in the examiner's answer related thereto.

Respectably Submitted,



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4/18/03

Date

  
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